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Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GREENE, SABRINA LETICIA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN G. HENRY

Appeal 2007-2777
Application 09/998,795
Technology Center 2100

Decided: March 21, 2008

Before JAMES D. THOMAS, KENNETH W. HAIRSTON,
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 11 and 13 through 31 since claim 12 was canceled in the amendment filed December 21, 2005. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

We have not reproduced in this decision a representative claim since the issue presented to us for decision relates only to the nature of the requirements for an affidavit or declaration filed within 37 C.F.R. § 1.131.

The following references are relied on by the Examiner:

Rudd	US 6,934,915 B2	Aug. 23, 2005 (filing date Oct 9, 2001)
Kloba	WO 01/18688 A2	Apr. 28, 2000

Claims 1, 5, 14, 15, 23, 24, and 26 through 31 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Rudd. To this reference the Examiner adds Kloba as to claims 2 through 4, 6 through 11, 13, 16 through 22, and 25 which stand rejected under 35 U.S.C. § 103(a).

Rather than repeat verbatim the positions set forth by the Appellant and the Examiner, reference is made to the Brief and Reply Brief for Appellant's positions, and to the Answer for the Examiner's positions.

OPINION

At least for the reasons set forth by the Examiner in the Answer, we sustain the rejection of the noted claims under 35 U.S.C. § 102 as well as those separately rejected under 35 U.S.C. § 103.

At the outset, we reproduce here paragraph (b) of 37 C.F.R. 1.131:

(b)The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

It is noted that the top of page 8 of the Final Rejection repeats these requirements of this rule.

The original declaration was submitted by Appellant with an amendment on December 21, 2005, and Appellant's declaration bears a signature date of December 15, 2005. Page 11 of this amendment only briefly mentions this declaration. It is also noted that certain claims were amended as well as a part of this amendment.

Pages 7 and 8 of the Final Rejection mailed on March 17, 2006, as well as page 8 of the Answer indicate the Examiner's view that there is not a sufficient showing of facts to determine the present invention defined by the claims was actually conceived before the October 9, 2001, filing date of Rudd.

Collectively, the Brief and Reply Brief urge that the declaration alone should be considered factual evidence within the rule to prove conception of the invention before the filing date of the Rudd patent followed by diligent constructive reduction to practice after the filing date of this reference to the filing date of December 3, 2001 of this application.

In view of these findings, we conclude that Appellant has not submitted the required factual showing noted earlier with respect to paragraph (b) of 37 C.F.R. § 1.131. The record before us does not establish that original exhibits of drawings or records or photocopies thereof accompanied the declaration filed under the rule and, correspondingly, there appears to be no explanation at all in the record to lead the Examiner to conclude that the absence of them was satisfactorily explained.

Thus, within the terms of part (b) of the rule, Appellant has not submitted facts in the form required by the rule of conception of the invention prior to the effective date of the reference coupled with due diligent from prior to that date to a constructive reduction to practice of the invention by the filing of this application. Therefore, we find no error in the Examiner's positions as to the anticipation rejection of the noted claims under 35 U.S.C. § 102(a). Although the Examiner's views are correct, they are incomplete as to the full extent of the submissions of facts to support Appellant's positions with respect to Rudd. These necessarily would include submissions of facts as to conception as well as to diligence up to the filing date of this application.

Because Appellant's arguments with respect to the second stated rejection of claims under 35 U.S.C. § 103 as expressed at page 17 of the principal Brief on appeal relies upon the arguments represented with respect to the alleged impropriety of the Examiner's positions in maintaining the rejection of 35 U.S.C. § 102 over Rudd, the rejection of the claims under 35 U.S.C. § 103 is affirmed as well. Furthermore, the merits of these rejections have not been argued before us.

Appellant's reliance at page 16 of the principal Brief and at pages 2 and 3 of the Reply Brief on *Ex parte Gilbert P. Hyatt* (1996 WL 1761844 (Bd. Pat. App. & Interf.)) is misplaced. It is plain within the analysis in this Board Decision that no affidavit or declaration was submitted under the provisions of 37 C.F.R. § 1.131. Although the Board does note a declaration was filed by the appellant in its reasoning, since it was submitted in the form to rebut an Examiner's case of prior public use or sale as alleged in the

Examiner's rejection, it only could have been submitted within the provisions of 37 C.F.R. § 1.132, which Appellant appears to recognize at the bottom of page 3 of the Reply Brief. There is no corresponding requirement of this latter rule that compares with the nature of the showing of facts required by 37 C.F.R. § 1.131(b) reproduced earlier and discussed in this opinion.

It is noted here that the nature of the submissions required by paragraph (b) of 37 C.F.R. § 1.131 is such as to permit the Examiner to determine adequacy of support for the claimed subject matter at the time it is before the Examiner. This is significant in the factual history of this application since the claims were amended at least once after their filing.

In view of the foregoing, the decision of the Examiner rejecting various claims under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed since Appellant has presented no evidence before us of error on the Examiner's part regarding these rejections.

Appeal 2007-2777
Application 09/998,795

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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